

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Docket Number (Optional)  
4022-000003/DVC

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Application Number  
10/784,090Filed  
February 20, 2004First Named Inventor  
Henry W. Bonk

On \_\_\_\_\_

Art Unit  
1772Examiner  
Walter B. Aughenbaugh

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.


I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 35-085.

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
Signature

Anna M. Budde  
Typed or printed name

248-641-1600  
Telephone number

August 4, 2010  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 10/784,090  
Filing Date: February 20, 2004  
Applicants: Henry W. Bonk et al.  
Group Art Unit: 1772  
Examiner: Walter B. Aughenbaugh  
Title: GAS-FILLED CUSHIONING DEVICE  
Docket No.: 4022-00003DVC

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**Pre-Appeal Brief Request for Review**

Hon. Commissioner of Patents  
and Trademarks  
Washington, D.C. 20231

Sir:

In connection with filing the accompanying Notice of Appeal from the rejections of the final Office Action mailed April 1, 2010, Applicants request a pre-appeal brief review.

Claims 1-7, 9, and 10 stand rejected on grounds of obviousness-type double patenting over certain claims of four earlier-filed patent applications owned by the same assignee (US Patents 6,013,340, 6,203,868, 6,652,940, and 6,692,803, which we will refer to as the Nike applications), each taken with Lee et al., US Patent 5,605,961. Applicants argue the Lee et al. patent is nonanalogous art and that there is no reason to turn to Lee to modify any of the cushioning devices claimed in the four earlier-filed Nike applications.

Applicants' claims are to gas-filled cushioning devices with a multi-layer film formed into a gas-filled membrane having an interior compartment containing a gas. The film has first and second layers. The first layer comprises a blend of at least one aliphatic thermoplastic polyurethane (up to about 50 wt.%), at least one aromatic thermoplastic polyurethane, and at least one EVOH copolymer. The second layer comprises a flexible resilient elastomeric thermoplastic material. The at least one thermoplastic polyurethane is formed by reaction of at least one polyester and/or polyether diol, at least one difunctional extender, and at least one aliphatic diisocyanate.

**I. Lee is nonanalogous art.**

Each of the rejections relies on a combination with the Lee patent, but the Lee et al. patent is nonanalogous art. A reference is analogous art only if "the reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned." *In re Kahn*, 441 F.3d 977, 986-87 (Fed. Cir. 2006).

The Lee patent concerns a resinous molding mixture in which a polyurethane and a polyolefin are compatibilized by adding a reaction product of a polyamide and modified polyolefin. The Lee patent is not in the field of the present invention, cushioning devices. These items do not have the same form and are not used in the same way; they do not belong to the same field of endeavor. Nor is the Lee patent relevant to solving any problem faced by Applicants, as Applicants' cushioning device and multi-layer film thereof do not include either a polyolefin or a reaction product of a polyamide and modified polyolefin. Nor does the Lee patent address the problem of making a cushioning device that would be essentially permanently inflated with nitrogen, remaining inflated though subjected to repeated impacts of considerable force. The Lee patent states that its purposes are "to provide a resinous mixture useful as a compatibilizing agent in

the context of thermoplastic compositions containing polyolefins,” “to provide compatible compositions containing TPU and polyolefin,” to provide a mixture useful to preparing these blends, and to provide a mixture containing a compatible blend of TPU with i-PP, col. 2, ll. 10-26. None of these goals are relevant to the present invention; nor do any of these goals recommend themselves to the claimed cushioning devices or even to the Nike application claims.

Further, to address the Examiner’s comments in the Advisory Action, Applicants point out that the claims neither recite baldly methods of making polyurethanes nor does the specification address some “problem” in polyurethane synthesis.

**II. There is no reason to look to Lee to modify the claimed cushioning devices of the prior-filed Nike patents.**

The Examiner argues that one would change the cushioning devices of the Nike applications because the Lee polyurethane “is a well known composition for formation of a thermoplastic molding composition.” Respectfully, Applicants dispute that this is a reasonable rationale for changing the cushioning devices of the Nike application claims. Applicants respectfully point out that, as of this date, there are more than 24,000 published US patent applications that have “polyurethane” in the abstract or the claims. By the Examiner’s reasoning, it is obvious to use all these polyurethanes because they are well-known.

An invention is not obvious when it would require varying all parameters or trying each of numerous possible choices until one possibly arrived at a successful result, particularly where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. *Bayer Schering Pharma v. Barr Labs.*, 91 USPQ.2d 1569, 1573-74 (Fed. Cir. 2009). Thus, where the options presented by the prior art

are not an “easily traversed, small and finite number of alternatives” there is no support for an inference of obviousness, particularly in the unpredictable chemical arts. *Eisai Co. v. Dr. Reddy’s Labs.*, 87 USPQ.2d 1452, 1457 (Fed. Cir. 2008).

Neither Applicants’ claims nor those of the Nike applications are to thermoplastic molding compositions or to molding. There is no reason to select a particular composition from Lee or from any other source merely because it is “well known” in some other context for some other purpose.

The Lee patent teaching that blends of polyurethane and polyolefin can be made more compatible by incorporating a reaction product of polyamide and modified polyolefin is also no recommendation for using it to modifying a gas-filled cushioning device. It must give the skilled artisan a reason to modify the cushioning devices of the Nike applications; make Applicants’ claimed cushioning device. It does not.

### **III. The combination does not provide all of the claim elements.**

The combination of claim 47 of US 6,013,340 and Lee fails to provide or make obvious the claim elements of a second layer that is an outer layer; a second layer comprising a flexible resilient elastomeric thermoplastic material, and the film permitting an inward diffusion pumping of a mobile gas constituent. Even if taken with claims 50-52 of US 6,013,340, the combination does not disclose the features of the outer layer, the diffusion pumping, or a thermoplastic polyurethane that is a flexible resilient elastomeric polyurethane.

The combination of claim 10 of US 6,203,868 and Lee fails to provide or make obvious the claim elements of a second layer that is an outer layer; a second layer comprising a flexible resilient elastomeric thermoplastic material, and the film permitting an inward diffusion pumping of a mobile gas constituent. Even if taken with claim 11 of US 6,203,868, the combination does

not disclose the features of the outer layer, the diffusion pumping, or a thermoplastic polyurethane that is a flexible resilient elastomeric polyurethane.

The combination of claim 22 of US 6,652,940 and Lee fails to provide or make obvious the claim elements of a second layer that is an outer layer; a second layer comprising a flexible resilient elastomeric thermoplastic material, and the film permitting an inward diffusion pumping of a mobile gas constituent. Even if taken with claim 11 of US 6,203,868, the combination does not disclose the features of the outer layer, the diffusion pumping, or a thermoplastic polyurethane that is a flexible resilient elastomeric polyurethane. Moreover, the present claims and claim 22 were determined by the Patent Office to be distinct inventions in parent application 09/170,790.

The combination of claim 21 of US 6,692,803 and Lee fails to provide or make obvious the claim elements of a second layer that is an outer layer; a second layer comprising a flexible resilient elastomeric thermoplastic material, and the film permitting an inward diffusion pumping of a mobile gas constituent. Even if taken with claim 22 of US 6,692,803, the combination does not disclose the features of the outer layer, the diffusion pumping, or a thermoplastic polyurethane that is a flexible resilient elastomeric polyurethane.

Respectfully submitted,

A handwritten signature in cursive script, reading "Anna M. Budde", is written over a horizontal line.

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August 4, 2010  
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